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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,297	11/14/2003	Derek John Webb	2674-108 (AMK)	8854
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NIXON & VANDERHYE, PC			HALL, ARTHUR O	
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ARLINGTON, VA 22203			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/712,297

Applicant(s)

WEBB, DEREK JOHN

Examiner

Arthur O. Hall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/14/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 13-18, 39-44 and 49-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10-12, 19-26, 30-34, 36-38, 45-48, 56-58 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

This application contains claims directed to the following patentably distinct species: Species I and II.

Species	Figures	Claims
I	1-2	1-9; 24-29; 30-35
II	3	13-18; 39-44; 49-54

Claims 10-12, 19-23, 36-38, 45-48, and 55-60 are directed to claims that either are non-statutory subject matter, do not further limit the parent claim or do not claim the invention, and thus, are not currently subject to the restriction requirement for elections of species. Therefore, claims 10-12, 19-23, 36-38, 45-48, and 55-60 will not be further treated on the merits with respect to prior art until the applicant recites the claims in a manner that places these claims in either Species I or II.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record. Moreover, the species are independent or distinct because Species I is directed to a game apparatus having and/or method of using a control means (See pg. 2, lines 9-12 and Fig. 2, 14), bus and computer (See Fig. 2, 20 and 24) and Species II is directed to a game apparatus having and/or method of using a player control means (See pg. 2, lines 9-12

and Fig. 3, 14A), network and internal bus (See Fig. 3, 32 and 24A), wherein each of these species have distinct utility from each other in that each species is capable of performing the task of manipulating instructions in a different structural and procedural manner.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic claims.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a

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claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

During a telephone conversation with Attorney Alan Kagen on 9/6/2007 a provisional election was made with traverse to prosecute the invention of Species I, claims 1-9, 24-29, and 30-35. Affirmation of this election must be made by applicant in

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replying to this Office action. Claims 13-18, 39-44 and 49-54 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "10" has been used to designate both "a screen, player control means and connection" in Fig. 3 and "a screen, control means, bus, computer, input module, output module, external bus and control module" in Fig. 2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the

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sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Objections

Claims 55 and 59 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 55 and 59 are apparatus and process claims, respectively, that are recited to depend from any or all of the preceding apparatus and process claims, respectively.

Claims 4-6, 8-9, 27-29, 35, 55 and 59 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from

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another multiple dependent, even if the multiple dependent claim is properly recited in the alternative. See MPEP § 608.01(n). Accordingly, the claims 4-6, 8-9, 27-29, 35, 55 and 59 have not been further treated on the merits.

Additionally, because claim 7 depends from claim 6, which is an improper multiple dependent, claim 7 is also objected to and has not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 60 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 60 fails to correspond in scope with that which applicant(s) regard as the invention can be found merely in that the structure or essential process steps of the applicant's invention are not defined. In the specification at least on pages 2-5, applicant has stated that the invention is an apparatus for and method of simulating the playing of a card game by a player, and this statement indicates that the invention potentially has structural features and process steps for carrying out the structural features that are clearly not recited in the claim, and thus as described in the disclosure of the specification, are different from what is defined in the claim because the claim merely recites "any novel subject matter or combination including novel subject matter disclosed herein" that does not allow the Examiner to clearly understand the metes and

bounds of the claimed invention. Accordingly, the claim 60 has not been further treated on the merits.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-12, 19-23, 36-38, 45-48 and 56-58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10, 19, 36, 45 and 56 reciting only computer software are functional descriptive material per se, which here is a judicial exception described as abstract ideas, since these claims are merely a compilation of data within a computer that are not stored on a computer-readable medium and no physical transformation of the simulated card image data occurs via means of the computer processor so as to produce a "tangible result" to a player. Thus, no practical application is provided since no physical computer-readable is recited from which the processor can execute the software code thereon in order to provide a "tangible result" to a player.

Claims 11-12, 20-23, 37-38, 46-48 and 57-58 reciting a carrier medium/member or a signal is nonfunctional descriptive material per se, which here is a judicial exception described as natural phenomena, since these claims merely recite energy that occurs naturally in nature and no physical transformation of the simulated card image data so as to produce a "tangible result" to a player occurs merely by transferring data via an energy wave that is a law of nature of which data substantially is transferred. Thus, no

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practical application is provided since no physical device is recited from which the processor can transfer the simulated card image data to be output in order to provide a "tangible result" to a player.

Hence, the card images are not physically transformed from the virtual world into the real world, and therefore, do not provide a tangible result in which the player receives the card images through display or another physical means. Accordingly, the claims 10-12, 19-23, 36-38, 45-48 and 56-58 have not been further treated on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 24-26 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews (US Patent 5,908,353) in view of Yoseloff (US Patent

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6,386,973 B1). Figures are described with reference characters where necessary for clarity.

Regarding claims 1 and 30, Andrews teaches

a gaming apparatus operable by a player to simulate a card game in which a hand of cards is dealt to the player (column 5, lines 21-26, Andrews) that comprises:

input means operable to receive instructions initiated by a player and relating to the playing of the game (column 5, line 64 to column 6, line 4 and Fig. 1, H and 40, Andrews; a player inputs instructions regarding game play via buttons);

output means operable to provide data for creating a display image representing the current state of the game being played (column 5, lines 45-49, column 6, lines 5-16 and Fig. 1, 20, Andrews; an output means or video display screen display card image data for the initial hand dealt and any subsequent hands dealt), and

wherein the apparatus is operable to cause the display image data to create an image of a player hand including at least one obscured card when first dealt (column 6, line 63 to column 7, line 12 and Fig. 2, 148, Andrews; two obscured or face down cards are displayed as image data of the players' dealt hand), and is further operable to modify the display image data in accordance with player instructions received by the input means, to cause the created image to reveal the or each obscured card in a manner determined by the player (column 7, lines 44-61, Andrews; upon election by the player with regard to their wager, the processor of the apparatus displays or reveals an obscured or face down card in its face up configuration), and

wherein the apparatus is operable to receive a player instruction representing at least one wager criterion (column 5, lines 49-63, Andrews; the processor of the apparatus takes as input the players' wager as an instruction upon displaying an initial dealt hand), and to assess the player hand in accordance with the wager criterion or criteria (column 6, lines 5-16, Andrews; the machine or processor of the apparatus evaluates the players hand with respect to the payable or wager criterion), and to effect

the placing of a wager, without player intervention, in the event that the wager criterion or criteria are met (column 6, lines 38-62, Andrews; game initiation is automatically made by the machine based on the players' wager being deposited).

However, Andrews does not substantially teach the control means features as claimed. Therefore, attention is directed to Yoseloff, which teaches a control means operable to maintain a record of the current state of the game being played (column 9, lines 52-57, Yoseloff; a random number generator or control means displays cards in an obscured or revealed state based on its selection of the program in the game), to modify the record in accordance with the rules of the game (column 9, lines 57-62, Yoseloff; the reveal state of the cards to the player is processed and altered based on the rules of the game), and to cause the display image data to be updated as the game progresses (column 9, lines 62-66, Yoseloff; automatic or manual update of the reveal state of the cards to the player during game play is provided).

Yoseloff suggests that a device that provides the player with a chance to discard and replace cards in a game with scoreable randomly chosen cards from a plural cards will give the player a chance to improve the ranking of their original card hand, thereby reducing the complexity of the rules and criteria of the game and bringing an element of excitement to the game play that has been lacking (column 1, line 16 to column 2, line 43 and column 2, line 61 to column 3, line 17, Yoseloff).

Thus, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to modify Andrews in view of the teachings of Yoseloff for the purpose of providing the gaming device of Andrews having obscured

card revelation features that are interchangeable with or upgradeable to the game play state and rules control features of Yoseloff in order to reduce rules complexity and make game play more exciting by enhancing the player's chance to improve the scoreable ranking of their cards in the game.

Regarding claim 24, the scope of the claim is substantially the same as claim 1 above with the only difference being that claim 1 is an apparatus claim and claim 24 is a process claim that recites the steps in which the apparatus is configured to perform.

Regarding claims 32-33, Andrews teaches

Regarding claim 32, the cards of a player hand are sequentially assessed by the control means and a wager is placed if the hand meets the or a wager criterion, without further assessment being made (column 6, line 63 to column 7, lines 43, Andrews; the machine places the player wager on hand upon sequential display of the hand to the player and evaluates the hand with respect to a payable or wager criterion for wager payoff, which is repeated for each subsequent hand).

Regarding claim 33, the apparatus is operable to cause the display image data to create an image of a player hand which includes at least one obscured card when first dealt (column 6, line 63 to column 7, lines 11, Andrews; two obscured cards or face down cards are displayed as card images by the machine or processor of the apparatus).

The claimed features of claims 2-3, 25-26, 31 and 34 do not appear to be disclosed in Andrews; therefore, attention is directed to Yoseloff, which teaches

Regarding claim 2, the control means is operable in response to received instructions to control the speed and/or order and/or timing of obscured cards being revealed (column 9, lines 57-62, Yoseloff; a random number generator or control means controls the timing of revelation of obscured cards based on player wager via button activation and all other features are obvious variants thereof).

Regarding claim 3, the apparatus is operable to provide an image of a partially revealed card (column 13, lines 39-49, Yoseloff; a partially revealed card is dealt by the processor).

Regarding claim 25, the scope of the claim is substantially the same as claim 2 above with the only difference being that claim 2 is an apparatus claim and claim 25 is a process claim that recites the steps in which the apparatus is configured to perform.

Regarding claim 26, the scope of the claim is substantially the same as claim 3 above with the only difference being that claim 3 is an apparatus claim and claim 26 is a process claim that recites the steps in which the apparatus is configured to perform.

Regarding claim 31, a wager criterion is interpreted as a minimum hand strength required for a wager to be placed (column 13, lines 21-31, Yoseloff; a minimum threshold value of a poker hand is a wager criterion for the player to participate in a game and obtain payout results).

Regarding claim 34, cards remain obscured if they have not been incorporated in an assessment of the strength of the hand against the wager criterion or criteria (column 10, lines 28-44 and column 13, lines 49-55, Yoseloff; a wager is made for payout

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assessment before, after or with the viewing of a players cards meaning that cards are obscured or not viewed before wager for payout assessment occurs to initiate activation of the game).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

C US-6,311,979 B1, Andrews

D US-5,382,025, Sklansky et al.

E US-5,531,448, Moody

F US-5,823,873, Moody

G US-5,947,821, Stone

H US-6,379,245 B2, De Keller

I US-6,345,823 B1, Webb

J US-6,626,433 B2, Scibetta

K US-5,803,808, Strisower

L US-6,550,771 B1, Weaver et al.

M US-4,926,327, Sidley.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur O. Hall whose telephone number is (571) 270-1814. The examiner can normally be reached on Mon - Fri, 8:00am - 5:00 pm, Alt Fri, EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AH

9/11/2007


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